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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Lam, *et al.*	Art Unit: 3722
Appl. No.: 10/678,231	Examiner: A. Abdelwahed
Filed: October 6, 2003	Atty. Dkt.:
For: **Artificial Eye for Doll or the Like**	

Reply Brief

Commissioner of Patents
U.S. Patent and Trademark Office
Customer Service Window, **MS Appeal Brief - Patents**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is a reply to the Examiner's Answer ("Answer") of October 20, 2005.

The Answer, like the Final Rejection, fails to acknowledge the significant differences between the structures, materials and functioning of artificial eyes and those of natural eyes. Due to these differences, one skilled in the art of artificial eyes, the art relevant to this appeal, would not be motivated to employ structures and materials employed for treating natural eyes in constructing artificial eyes.

In particular, the Answer states that:

> [T]he Deeg et al. reference was combined with the Nasca and Smith references merely to teach the concept of having a lens for an eye being made of the various materials recited in the claims on appeal.

Answer at 5.

This statement glosses over the fact that the lens of Deeg is for a natural eye and those of Nasca and Smith are for artificial eyes. As pointed out in the Appeal Brief, the lens material characteristics sought by Deeg of light weight (and density), chemical stability, biological inertness and suitable refractive index are largely unimportant to the lens material characteristics sought by Appellants of clarity, hardness and sparkle. This is because, other than transparency, the functioning of lenses for artificial eyes and natural eyes are totally dissimilar.

The Answer further argues that the structural differences between Nasca and Smith on the one hand and Deeg on the other are irrelevant because Deeg's disclosure does not focus on an eye structure and Deeg does not claim such a structure. Answer at 5. This argument again treats all eye structures as if they emanate from a common technology. In fact, the lens of Deeg is intended for use only in natural eyes and not in artificial eyes, such as those of Nasca and Smith. Moreover, contrary to the sentence bridging pages 5 and 6 of the Answer, Deeg does not teach that hardness and durability are desirable characteristics of replacement lenses for natural eyes. The desirability of hardness and durability for lenses is taught only in the present application, and only for artificial eyes.

Finally, the Answer contends that since Smith teaches that his artificial eye can be used as a replacement for a natural eye and Deeg discloses an artificial lens for a natural eye, "both references are clearly within the same field of endeavor." Answer at 6. An artificial eye that can be used as a replacement for a natural eye is still an artificial eye. No light images are transmitted through and focused by an artificial eye for sensing by an optic nerve. An artificial eye replacement for a natural eye is a biologically non-functional, cosmetic appliance, just as it is in a doll or other toy. The Nasca and Smith disclosures and the present application relate to such cosmetic appliances. The Deeg disclosure relates to "improvements in ophthalmology." Col.1, lines 5-6. One skilled in the art of artificial eyes would not be motivated to employ the materials used in medical procedures for treating natural eyes.

For the foregoing reasons, the reference combinations of Nasca and Deeg and Smith and Deeg are improper. The rejections based on those combinations similarly are improper and should be reversed.

Oral Hearing

An oral hearing is not requested.

Respectfully submitted,

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